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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ABRAHAM I. ZEIGLER,
RICHARD G. KETCHUM, and
ALFRED R. BERKELEY III

Appeal 2009-007849
Application 09/401,875
Technology Center 3600

Decided: July 22, 2010

Before HUBERT C. LORIN, JEAN R. HOMERE, and
BIBHU R. MOHANTY, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

Abraham I. Zeigler (Appellants) seek our review under 35 U.S.C. § 134 of the Examiner's final decision rejecting claims 1-23. We have jurisdiction over the appeal under 35 U.S.C. § 6(b).

We AFFIRM.

BACKGROUND

Appellants' invention is directed to a method of "trading securities include[ing] receiving additional aggregate size quotes for a security." Specification 1:3-5.

Claim 1 is illustrative:

1. A method, executed in a computer server system of an electronic market, for managing quotes for a security, the method comprising:

receiving by the server computer system from client systems used by market participants, additional aggregate quotes, the additional aggregate quotes having a size value with the additional aggregate quotes being quotes that are displayable on displays of client systems, as trading interest in a security, but not being attributable to any market participant.

The Examiner relies on the following prior art reference as evidence of unpatentability:

Gutterman WO 91/14231 Sep. 19, 1991

Appellants appeal the following rejections:

1. Claims 1-23 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

2. Claims 1-23 are rejected under 35 U.S.C. §102(b) as being anticipated by Gutterman.

APPELLANTS' CONTENTIONS

Regarding the 35 U.S.C. § 102 rejection, the Appellants do not contest the Examiner's finding (Ans. 5) that Gutterman expressly describes a computer server system that receives displayable information. Reply Br. 4.

The Appellants contend that the Examiner has not established a prima facie case of anticipation because not all the claimed limitations have been shown to be described in Gutterman. Specifically, the Appellants argue that Gutterman does not describe "aggregate quotes" and "displayable ... as trading interest in a security, but are not attributable to any market participant." See claim 1, App. Br. 15 and Reply Br. 1-5. Other contentions directed to claims other than claim 1 are addressed below.

ISSUE

Does Gutterman anticipate the claimed subject matter?

FACTUAL FINDINGS

On the anticipation question, we adopt all of the Examiner's findings as our own. Ans. 5-9.

Additional findings of fact may appear in the Analysis that follows.

ANALYSIS

The rejection of claims 1-23 under 35 U.S.C. §112, second paragraph.

We reverse this rejection.

The Examiner (Ans. 3) found the claims indefinite because, in the Examiner's opinion, certain language contained in claims 1, 12-15, 18, 20, and 23 had "insufficient antecedent basis" was "indefinite and vague", or, as a result of the language, "the metes and bounds of the claim cannot be defined" or "are unclear."

The difficulty with this rejection is that the Examiner concluded that the claims are indefinite without looking to the Specification or accounting for the level of skill. "As a general matter, it is well-established that the determination whether a claim is invalid as indefinite 'depends on whether those skilled in the art would understand the scope of the claim when the claim is read in light of the specification.'" *North Am. Vaccine, Inc. v. American Cyanamid Co.*, 7 F.3d 1571, 1579 (Fed.Cir. 1993); *see Miles Lab., Inc. v. Shandon, Inc.*, 997 F.2d 870, 875 (Fed.Cir. 1993).

This sort of claim construction analysis is important because the questions of whether claim language causes a claim scope to be indeterminate or failing to have antecedent basis depends on it. This is so because indefiniteness does not necessarily follow from the fact that claims are broad. *See In re Robins*, 429 F.2d 452, 458 (CCPA 1970)("Giving the language its broadest possible meaning, as we are bound to do in the absence of special definitions by appellant, the breadth of the claims insofar as the catalyst is concerned is indeed immense. However, 'Breadth is not indefiniteness'." *In re Gardner*, 427 F.2d 786 788 (1970). Likewise, although a "[l]ack of an antecedent basis in a claim *could* render it invalid under 35 U.S.C. § 112," *In re Altenpohl*, 550 F.2d 1151, 1156 (CCPA 1974)

(emphasis added), antecedent basis can be present by implication (*see Slimfold Mfg. Co. v. Kinkead Indus., Inc.*, 810 F.2d 1113, 1116 (Fed. Cir. 1987).

Because the necessary analysis for reaching the conclusion that the claims are indefinite was not provided, a prima facie case that the claims are indefinite is not established in the first instance.

The rejection of claims 1-23 under 35 U.S.C. §102(b) as being anticipated by Gutterman.

We will affirm this rejection.

Claims 1 and 10

The Appellants argue claims 1 and 10 as a group (App. Br. 15). We select claim 1 as the representative claim for this group, and the remaining claim 10 stands or falls with claim 1. 37 C.F.R. § 41.37(c)(1)(vii) (2007).

The Appellants argue that Gutterman does not describe the claim limitations “aggregate quotes” and “displayable ... as trading interest in a security, but are not attributable to any market participant” as claimed. The argument is unconvincing.

There is no dispute that Gutterman describes a computer system that receives information and displays it. The Appellants are arguing that the system claimed receives particular information, *i.e.*, “aggregate quotes” and those are “displayable ... as trading interest in a security, but are not attributable to any market participant”. That “aggregate quotes” refer to a content of information is evidenced by the fact that the Specification exemplifies an aggregate quote as a number (*see* p. 9, ll. 12-29, *e.g.*, “3,000”). In our view, such an alleged distinction - that the Appellants have

drawn their claimed invention to “aggregate quotes” and not to some other type information - is not patentably consequential. It is a distinction based on the descriptive material being received and displayed. Patentable weight need not be given to descriptive material absent a functional relationship between the descriptive material and the substrate (here the computer system and/or display). See *In re Lowry*, 32 F.3d 1579, 1582-83 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 1338 (Fed. Cir. 2004); *In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability); *Ex parte Mathias*, 84 USPQ2d 1276, 1279 (BPAI 2005) (informative). (“[O]ur reviewing court has held that nonfunctional descriptive material cannot lend patentability to an invention that would have otherwise been anticipated by the prior art”); and *Ex parte Curry*, 84 USPQ2d 1272, 1275 (BPAI 2005) (informative) (“Common situations involving nonfunctional descriptive material are: - a computer-readable storage medium that differs from the prior art solely with respect to nonfunctional descriptive material, such as music or a literary work, encoded on the medium, - a computer that differs from the prior art solely with respect to nonfunctional descriptive material that cannot alter how the machine functions (*i.e.*, the descriptive material does not reconfigure the computer), or - a process that differs from the prior art only with respect to nonfunctional descriptive material that cannot alter how the process steps are to be performed to achieve the utility of the invention.

Thus, if the prior art suggests storing a song on a disk, merely choosing a particular song to store on the disk would be presumed to be well within the level of ordinary skill in the art at the time the invention was

made. The difference between the prior art and the claimed invention is simply a rearrangement of nonfunctional descriptive material.).”

In that regard, the Appellants have not come forward with evidence sufficient to show that the structure of the computer and/or display are functionally affected by them providing, specifically, “aggregate quotes”.

As to the information being “displayable . . . as trading interest in a security, but are not attributable to any market participant”, this merely sets an intended purpose for the information and does affect the structure of the computer and/or display. It represents an “intended use” which, as such, does not patentably distinguish the claimed method from Gutterman.

For the foregoing reasons, we are not persuaded that a *prima facie* case of anticipation has not been established for subject matter of claims 1-10.

Claims 2 and 11

The Appellants argue claims 2 and 11 as a group (App. Br. 17). We select claim 2 as the representative claim for this group, and the remaining claim 11 stands or falls with claim 2. 37 C.F.R. § 41.37(c)(1)(vii) (2007).

The Appellants argue that “Gutterman does not describe receiving a second, different type of order/quote.” App. Br. 17. We find the argument unpersuasive for the reasons given *supra* on the subject of nonfunctional descriptive material.

For the foregoing reasons, we are not persuaded that a *prima facie* case of anticipation has not been established for subject matter of claims 2 and 11.

Claim 3

The Appellants argue that Gutterman does not describe reserve quotes. App. Br. 18. We find the argument unpersuasive for the reasons given *supra* on the subject of nonfunctional descriptive material.

For the foregoing reasons, we are not persuaded that a *prima facie* case of anticipation has not been established for subject matter of claim 3.

Claims 4-7

The Appellants argue claims 4-7 as a group (App. Br. 18). We select claim 4 as the representative claim for this group, and the remaining claims 5-7 stand or fall with claim 4. 37 C.F.R. § 41.37(c)(1)(vii) (2007).

The Appellants argue that Gutterman does not describe total aggregate quote size. App. Br. 18. We find the argument unpersuasive for the reasons given *supra* on the subject of nonfunctional descriptive material.

For the foregoing reasons, we are not persuaded that a *prima facie* case of anticipation has not been established for subject matter of claims 4-7.

Claims 8 and 9

The Appellants argue claims 8 and 9 as a group (App. Br. 20). We select claim 8 as the representative claim for this group, and the remaining claim 9 stands or falls with claim 8. 37 C.F.R. § 41.37(c)(1)(vii) (2007).

The Appellants argue that Gutterman does not describe total aggregate quote size. App. Br. 20. We find the argument unpersuasive for the reasons given *supra* on the subject of nonfunctional descriptive material.

For the foregoing reasons, we are not persuaded that a *prima facie* case of anticipation has not been established for subject matter of claims 8 and 9.

Claim 12

The Appellants argue that Gutterman does not describe “executing additional aggregate quotes and reserve quotes to any balance of the order to execute the balance of the order.” App. Br. 20. Notwithstanding that the type of information executed is patentably inconsequential; the argument is not commensurate in scope with what is claimed. The claim requires no executing of a balance of the order. The Appellants further argue that its system performs the execution as part of an “auto execution process”. App. Br. 21. That, too, is not claimed.

For the foregoing reasons, we are not persuaded that a prima facie case of anticipation has not been established for subject matter of claim 12.

Claims 13, 14, 16, and 17

The Appellants argue claims 13, 14, and 17 as a group (App. Br. 21). Claim 16 does not appear to have been separately argued. Because it depends from claim 13, we include it in this group. We select claim 13 as the representative claim for this group, and the remaining claims 14, 16, and 17 stand or fall with claim 13. 37 C.F.R. § 41.37(c)(1)(vii) (2007).

The Appellants argue that Gutterman does not describe aggregate quotes. App. Br. 21. We find the argument unpersuasive for the reasons given *supra* on the subject of nonfunctional descriptive material.

For the foregoing reasons, we are not persuaded that a prima facie case of anticipation has not been established for subject matter of claims 13, 14, 16, and 17.

Claim 15

The Appellants argue that Gutterman does not describe the particular displayed “montage” claimed. App. Br. 21. Fig. 7 of the Specification apparently shows one example of a “montage.” A “montage,” as shown in the Specification, is a “composite picture”. See *Webster’s New World Dictionary* 880 (3rd Ed. 1988.) (Entry for “montage.”) Accordingly, the argument over the claimed montage is an argument in favor of the patentability of giving certain information a graphical perspective. We find that sort of argument unpersuasive for the reasons given *supra* on the subject of nonfunctional descriptive material.

For the foregoing reasons, we are not persuaded that a *prima facie* case of anticipation has not been established for subject matter of claim 15.

Claims 18 and 19

The Appellants argue claims 18 and 19 as a group (App. Br. 22). We select claim 18 as the representative claim for this group, and the remaining claim 19 stands or falls with claim 18. 37 C.F.R. § 41.37(c)(1)(vii) (2007).

The Appellants argue that Gutterman does not describe aggregate and reserve quotes. App. Br. 22. We find the argument unpersuasive for the reasons given *supra* on the subject of nonfunctional descriptive material.

For the foregoing reasons, we are not persuaded that a *prima facie* case of anticipation has not been established for subject matter of claims 18 and 19.

Claims 20-23

The Appellants argue claims 20-23 as a group (App. Br. 23). We select claim 20 as the representative claim for this group, and the remaining

claims 21-23 stand or fall with claim 20. 37 C.F.R. § 41.37(c)(1)(vii) (2007).

The Appellants argue that Gutterman does not describe attributable and non-attributable aggregate quotes. App. Br. 23. We find the argument unpersuasive for the reasons given *supra* on the subject of nonfunctional descriptive material.

For the foregoing reasons, we are not persuaded that a *prima facie* case of anticipation has not been established for subject matter of claims 20-23.

DECISION

We reverse the Examiner's § 112, second paragraph, rejection of claims 1-23.

We affirm the Examiner's § 102(b) rejection of claims 1-23 as anticipated by Gutterman.

TIME PERIOD

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1) (2009).

ORDER

AFFIRMED

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Appeal 2009-007849
Application 09/401,875

FISH & RICHARDSON PC
P.O. BOX 1022
MINNEAPOLIS MN 55440-1022